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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,762	07/26/2000	Hideto Horikoshi	JA919990082US1	8025

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EXAMINER

HARRY, ANDREW T

ART UNIT	PAPER NUMBER
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2686

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DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,762

Applicant(s)

HORIKOSHI ET AL.

Examiner

Andrew T Harry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,10 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Response to Amendment

The Examiner acknowledges the receipt of the Applicant's amendment filed August 4, 2003. In the Amendment claims 2, 8, 11-13, and 17-19 have been cancelled and claims 1, 6-7, and 9-10 have been amended. Claims 1, 3-7, 9-10, and 14-16 are currently pending in the application.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-7, 9-10, and 14-16 have been considered but are moot in view of the new ground(s) of rejection. The Applicant significantly amended claims 1 and 10 by adding the previously rejected subject matter of the claims cancelled in this amendment and added some additional limitations not previously disclosed in the claims. For these reasons the Examiner has restructured his rejection.

Claim Objections

Claims 7 and 10 are objected to because of the following informalities: The acronym "FET" is used before being defined in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by *Wecker et al* U.S. Patent 6,289,464 (“*Wecker*”).

As pertaining to **claim 1**, *Wecker* teaches a method for receiving a wireless signal by a computer adapted to operate in a power saving mode (see *Wecker*, abstract), said method comprising:

providing a plurality of status bits to indicate whether or not an RF module is attached to said computer and is activated (see *Wecker*, col. 6 line 57-col. 7 line 21, clearly the protocols described here (PCMCIA/Flash) provide the device with an exchange of bits indicating what devices are installed);

detecting within a computer a wireless signal representing a bit sequence when said computer is operating in a power-saving mode, wherein said wireless signal is targeted for said computer (see *Wecker*, col. 9 lines 1-28);

determining whether a wireless signal receiver device is installed and enabled by reading a plurality of status signals or digital bits (see *Wecker*, col. 6 line 57-col. 7 line 21);

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exiting power-saving mode only if RF module is attached to said computer and is activated (see *Wecker*, col. 9 lines 29-42, the device only gets to this point if the computer has already sensed a wireless device);

regenerating some or all of said bit sequence of said wireless signal (see *Wecker*, col. 9 line 43-col. 10 line 59); and

storing said some or all of said bit sequence of said wireless signal in a memory after exiting said power-saving mode (see *Wecker*, col. 11 lines 24-40 and col. 13 lines 45-65).

As pertaining to **claim 3**, in *Wecker's* method said detecting further includes detecting a particular identification tag embedded in said bit sequence (see *Wecker*, col. 9 lines 13-28, and address is included in the received messages and read by the receiver).

As pertaining to **claim 4**, in *Wecker's* method the wireless signal is transmitted though a radio frequency channel (see *Wecker*, col. 6 lines 57-62).

As pertaining to **claim 5**, in *Wecker's* method the wireless signal can be a "high priority" message and thus inherently include a request for the computing device to exit said power-saving mode (see *Wecker*, col. 9 lines 36-42 and col. 10 lines 22-27).

As pertaining to **claim 6**, in *Wecker's* method said bit sequence may include a request to resume execution of a program that has been suspended when said computer is in said power-saving mode (see *Wecker*, col. 13 lines 45-65, *Wecker* describes that once the information is stored in the device it can be used by "higher level application modules" that were active prior to the device entering sleep mode and could be resumed upon the device emerging from the sleep state).

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setting said switch to maintain power to said receiving means prior to entering said power-saving mode (see *Wecker*, col. 7 lines 22-46 and col. 8 lines 44-67, here *Wecker* describes that while the power switch of the device is on the receiver is on regardless of device mode and when the power switch is off, the receiver is off).

As pertaining to **claim 9**, *Wecker's* method includes:

processing information conveyed by said bit sequence (see *Wecker*, col. 9 line 43-col. 10 line 59); and

automatically returning to said power saving mode after said processing (see *Wecker*, col. 9 line 43-col. 10 line 59, once the information is processed the device, if inactive, may return to the power saving mode the same way it had entered it previously).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims, **7, 10, and 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wecker* in view of well known prior art in the field of the invention.

As pertaining to **claim 7**, *Wecker* teaches that an interface is in place in order to provide signal connections and power to the attached device even while the computer is in sleep mode. See *Wecker*, col. 6 line 57-col. 7 line 32. *Wecker* does not, however, provide any details regarding the type of electronic switch that is used to provide power to the device. The

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Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time of the invention to use an FET switch to maintain power to said receiving means. This would have allowed the device to have an efficient use of power and to easily be switched on and off through the connection with the computer.

As pertaining to **claim 10**, *Wecker* teaches a computer for receiving a wireless signal while in a power-saving mode (see *Wecker*, abstract), said computer comprising:

a receiving means adapted to detect a wireless signal representing a sequence of bits, wherein said receiving means is adapted to regenerate some or all of said bit sequence, wherein said wireless signal is targeted for said computer (see *Wecker*, col. 9 line 1-col. 10 line 59);

a plurality of status bits to indicate whether or not an RF module is attached to said computer and is activated (see *Wecker*, col. 6 line 57-col. 7 line 21, clearly the protocols described here (PCMCIA/Flash) provide the device with an exchange of bits indicating what devices are installed)

a power-saving mode control means adapted to exit said power-saving mode exiting power-saving mode only if RF module is attached to said computer and is activated (see *Wecker*, col. 9 lines 29-42, the device only gets to this point if the computer has already sensed a wireless device)

a switch for enabling power to said receiving means when said computer is in said power-saving mode (see *Wecker*, col. 7 lines 22-46 and col. 8 lines 44-67, here *Wecker* describes that while the power switch of the device is on the receiver is on regardless of device mode and when the power switch is off, the receiver is off); and

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a memory for storing said some or all of said regenerated bit sequence after said computer has exited said power saving mode (see *Wecker*, col. 11 lines 24-40 and col. 13 lines 45-65, the but sequence is not only stored is processed and potentially displayed on the device).

Wecker teaches that an interface is in place in order to provide signal connections and power to the attached device even while the computer is in sleep mode. See *Wecker*, col. 6 line 57-col. 7 line 32. *Wecker* does not, however, provide any details regarding the type of electronic switch that is used to provide power to the device. The Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time of the invention to use an FET switch to maintain power to said receiving means. This would have allowed the device to have an efficient use of power and to easily be switched on and off through the connection with the computer.

As pertaining to **claim 14**, in *Wecker's* device said receiving means is an optional attachment to said computing device (see *Wecker*, col. 4 lines 33-42).

As pertaining to **claims 15 and 16**, *Wecker* does not specifically describe how the receiving means is formed or attached to the computing device. However it would have been obvious to one of ordinary skill in the art at the time of the invention that a device bay cover as an optional attachment could have been used to connect the wireless receiver to the computing device. *Wecker* describes that the computing device could be connected to networks in various different configurations (see *Wecker*, col. 4 lines 34-42), thus indicating that various connections could have been added to and detached from the device. A simple design choice could have been made to make the attached receiver be attached via an optional device bay cover, and the

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addition or deletion of this bay cover alone would not make the claimed invention patentable over *Wecker*.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Harry whose telephone number is 703-305-4749. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

ATH


CHARLES APPIAH
PRIMARY EXAMINER